

REMARKS

5 Applicant has received and carefully reviewed the Office Action of June 29, 2004. Applicant notes that the Examiner has finally rejected claims 80-83, 85-92, 102, 103, 105-116, 120-123, 125, 131, 132, 133, 134-138, and maintains her objection to claims 84, 93-101, 104, 117-119, and 126-129.

Claim rejections under 35 USC §112

10 The Examiner rejected claims 98 and 105 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner cited apparent typographical errors in both claims. The rejections under 35 USC §112 have been addressed by amendment of both claims, and Applicant requests the rejection be withdrawn as moot.

15 **Claim rejections under 35 USC §103**

20 The Examiner has finally rejected a number of claims under 35 USC §103(a) in view of the disclosures of Grauptner et al. (WO 98/04119) and Packard et al. (1993) for the reasons set forth in the previous Office Action. Applicant respectfully traverses this rejection.

25 The Examiner states in her rejection that Packard et al. was relied upon for the assessment of particles in milk. However, as already pointed out in Applicant's response to the previous Office Action, Packard does not disclose a method for the assessment of particles in milk. Packard merely describes on page

299: *Somatic cell counts were determined by the automated fluorescent dye procedure described in Standard Methods for the Examination of Dairy Products* (6). Reference number (6) of Packard et al. refers to: Richardson, G.H.(Ed.) (1985) *Standard Methods for the Examination of Dairy Products*, 15th Ed. American Public Health Association, Washington, DC, pp. 94-99.

However, the pages referred to do not relate to assessment of particles in milk, but they relate to sampling dairy and related products. Applicant has studied other pages of this textbook, but not been able to unambiguously establish which 10 automated fluorescent dye procedures Packard et al. intended to refer to. This leaves Applicant in a position where his application has been rejected and he cannot verify Examiner's claims in the Office Action that, "*The methods of Packard are fully compatible with the automated system of Grauptner.*" and "*Packard notes that the assessments were done by well known, often performed methods (p299, second full paragraph) which appears to be the same methods as those encompassed by the claims.*"

The Examiner has referred to Packard et al. for teaching particle assessment. Packard et al. refer to an *automated fluorescent dye procedure* used for 20 the counting of somatic cells. In 1993, when Packard et al. was published, only one kind of *automated fluorescent dye procedures* was commonly available, namely fluoro-opto-electronic methods (either performed using the rotating disk technique or using flow cytometry). In support of this position, the Applicant is submitting a declaration under 37 C.F.R. §1.132 and relevant documentation relating to the state

of the art at the time of the Packard reference. See point 4 of the attached Declaration by the inventor.

Thus, in the absence of a reference to a document containing an actual technical teaching, Packard et al. can only be used as a reference to teach the most commonly used fluoro-opto-electronic method at the time, which is described under "Method C" in a publication by the International Dairy Federation: the International IDF Standard 148A:1995 (enclosed herewith). Furthermore, in the Declaration under point 5, the inventor has explained how an assessment of particles in milk is carried out when using the fluoro-opto-electronic method and what the characteristics of this method are. Under point 6, the method of the present invention is described. Under point 7 of the Declaration, the inventor explains in detail why the fluoro-opto-electronic method could not be integrated into a process for a regulating a milking process.

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The Examiner has stated on page 3, lines 3-10 of the Detailed Action that: "*Packard notes that the assessments were done by well known, often performed methods which appears to be the same methods as those encompassed by the claims.*" ... *The methods of Packard are fully compatible with the automated system of Grauptner et al.*" In view of the technical problems explained in the Declaration, Applicant submits therefore that the fluoro-opto-electronic method is not compatible with the automated system of Grauptner et al., and cannot therefore form the basis of a valid rejection.

Applicant submits that the Examiner cannot maintain a *prima facie* obviousness rejection under 35 U.S.C. §103(a) because the prior art references when combined do not teach or suggest all the claim limitations. Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Neither reference teaches or suggests how to adapt the analytical methods of Packard for analyzing particles in the milk as the milk is flowing from the milking apparatus, i.e. in real-time as claimed in the present invention. Thus, the rejection does not teach each and every limitation of the claimed invention. While it may be obvious to try to combine the two teachings, to arrive at the present invention, neither reference teaches all the claim elements, and the Examiner has not provided a reasoned basis of how one of skill in the art would combine the two teachings with a reasonable expectation of success.

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When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). "An Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an

Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability." Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 5 1551, 1554 (Fed. Cir. 1996). See also, In re Rouffet, 149 F.3d 1350, 1357-58, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)(...To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness).

10 The Applicant respectfully puts forth that the Examiner appears to be using hindsight and Applicant's own disclosure to make the *prima facie* case. The Examiner has failed to show how one of skill in the art would have been motivated to combine the teachings of Grauptner in view of Packard, nor show how in the art this would have been accomplished absent Applicants own teachings, and therefore the

15 Applicant respectfully requests that the rejection be withdrawn.

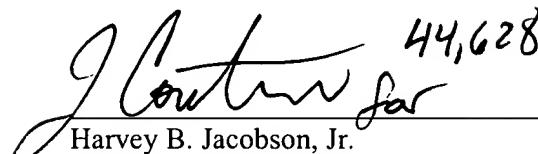
20 All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all currently outstanding rejections, and that they be withdrawn.

It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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